

## **REMARKS**

### **1. Summary of the Office Action**

In the Office Action mailed March 4, 2009, the Examiner rejected claims 1, 7, 9, and 10 under 35 U.S.C. §102(e) as being anticipated by Weniger (U.S. Pat. Pub. No. 2004/0087898). The Examiner further rejected claims 5, 6, 8, 11, and 12 under 35 U.S.C. §103 as being unpatentable over Weniger. The Examiner also rejected claims 2-4 under 35 U.S.C. §103 as being unpatentable over Weniger in view of Greter (U.S. Pat. Pub. No. 2004/0029486). The Examiner also objected to the specification, requiring the Abstract to be on a separate sheet, and requiring a new copy of the description being double-spaced. Applicant submits herewith a substitute specification. The substitute specification contains no new matter. Claims 1, 2, 6-9, and 11-12 have been amended, and new claims 13-17 have been added. No new matter has been added. For the reasons given below, Applicant respectfully submits that the references taken alone or in combination do not disclose, teach, or even suggest the presently claimed invention.

### **2. Present application**

The present application discloses a breast cap (funnel or shield) having a removable insert. The insert has a chamber filled with a medium, which may be a heat-accumulating or heat-conducting material. The insert may be removed from the funnel to be warmed either before or during its use. The mother can therefore decide which temperature the insert should have and she can check the temperature by holding the insert to her wrist, her face, or another temperature sensitive body part. The mother can remove the insert from the breast shield when she wants to check the temperature before use. Further, in some embodiments, the insert may be heated independently of the breast shield and breast pump.

In one embodiment, the breast cap insert is heated by the current supply of the breast pump. In another embodiment, a heating system is arranged in the breast shield, and is activated by a trigger located in the breast cap insert.

### **3. Rejection under §102(e)**

The Examiner rejected claims 1, 7, 9, and 10 as being anticipated by Weniger. Applicant submits that the cited reference does not anticipate the present claims.

According to M.P.E.P. §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In this case, Weniger discloses a breast shield with a heating element. There is a disclosure that an insert can be arranged in the heated breast shield, wherein the insert is warmed when the breast shield is heated. However, as admitted by the Examiner on page 4 of the Office Action, Weniger does not disclose a breast shield insert with at least one resistance heating element and electrical contact element as recited in amended claim 1. The Examiner further admitted on page 4 of the Office Action that Weniger does not disclose a trigger for activating a heating system in the breast cap, as recited in independent claim 6. Thus, for at least these reasons, the rejection is improper and should be withdrawn.

Furthermore, contrary to the Examiner's position, Weniger also does not disclose the insert base body being made of a polyurethane foam or polyolefin foam, as recited in claim 9. The Examiner cited to paragraph [0061] of Weniger for disclosing this feature. However, the only material disclosed by Weniger in paragraph [0061] is a flexible, silicone-based material. Thus, for this additional reason, the rejection is improper and should be withdrawn.

#### **4. Rejection under §103(a)**

The Examiner rejected claims 5, 6, 8, 11, and 12 as being unpatentable over Weniger. Applicant respectfully disagrees. Weniger discloses a breast shield which may include a heating element 300. The heating element is located directly on the breast shield 60 and cannot be removed. The breast shield may further include a removable insert 110 for adapting the breast shield for use with different breasts. (Weniger, p. 3, [0036]).

Regarding claim 1, the Examiner submits that warming the insert independently of the breast cap is well known in the art. However, there is no disclosure or suggestion in Weniger that the heating element be located on the insert rather than on the breast shield. Further, the insert is a cheap, disposable element. Providing a heating element on the insert would make the insert more expensive, and thus would not be an obvious variation to one of ordinary skill in the art. Thus, for at least this reason, the rejection is improper and should be withdrawn.

Regarding claim 6, Weniger does not disclose the insert having a trigger for activating a heating system in the breast cap. The Examiner submits that it would be obvious to provide a trigger as a means to control the heating element. However, there is no teaching or suggestion that the trigger would be present on the insert. In Weniger, the insert simply functions to adapt the breast shield for different breasts, and is in no way connected to the heating system. The heating system of the breast shield functions on its own without any help from the insert. Thus, for this additional reason, the rejection is improper and should be withdrawn.

Regarding new claim 13, Weniger does not disclose or suggest the insert being made of a heat-accumulating or heat-conducting material, and also does not suggest that the insert be made of a medical paraffin oil or petrolatum. Thus, claim 13 is also patentable over Weniger.

As to new claim 14, Weniger does not disclose the base body of the insert being heat-conducting and containing an element carried by the base body. Rather, Weniger discloses the breast cap having a heating element and an insert arranged in the heated breast shield, wherein the insert is warmed when the breast cap is heated. There is no separate element located within the insert that warms the insert. Thus, claim 14 is allowable over the cited art.

Dependent claims 7, 8, 11, 12, and 15-17 are also allowable for at least the reasons that their independent base claims are allowable.

The Examiner rejected claims 2-4 over Weniger in view of Greter. Greter also does not disclose a heating element located in an insert, the insert having a trigger, or the insert being made of a heat-conducting material. Thus, claims 2-4 are also allowable over the cited art.

Applicant also submits that Weniger is not prior art under §103(a). As explained in the Silver Declaration, attached hereto as Exhibit A, the invention disclosed in Weniger (U.S. Pub. 2004/0087898) was conceived of and developed when Weniger was employed by Medela, Inc. Thus, at the time the invention was made, if Weniger had any inventive contribution, this was actually owned by Medela, Inc. since Weniger was employed there and, under Illinois law, had the obligation to assign any patent applications (see Baniak Declaration, attached hereto as Exhibit B). Medela, Inc. is a subsidiary of Medela Holding AG, the assignee of the present application (see ¶6 of Exhibit B). Thus, since Weniger only would qualify as prior art under §102(e), it cannot be used in an obviousness rejection, pursuant to §103(c).

## **Conclusion**

Applicant respectfully submits that, in view of the remarks above, all of the pending rejections have been overcome. Applicant therefore respectfully requests allowance of all the

pending claims. The Examiner is invited to call the undersigned at (312) 913-3334 with any questions or comments.

Respectfully submitted,

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Date: September 2, 2009

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